

REMARKS

Claims 1, 5, 9-17, 19-25, 27 and 28 are pending in this application. By this amendment, claims 5 and 23 are amended and claims 18 and 26 are cancelled. Reconsideration of the application in view of the following marks is respectfully solicited.

Entry of the amendments to claims 5 and 23 is proper under 37 CFR §1.116 because the amendments: a) place the application in condition for allowance (for all the reasons discussed herein); b) do not raise any new issues requiring further search or consideration; c) place the application in better form for appeal (if necessary); and d) address a formal requirement of the Office Action. Accordingly, entry is proper under 37 CFR §1.116.

III. Rejections Under 35 U.S.C. § 112

Item 3 rejects claims 1, 5, 9-18 and 23-28 under 35 U.S.C. § 112 second paragraph in view of various informalities identified in Item 3.

With respect to the rejection of claims 1 and 5 as being indefinite for being unclear regarding their Jepson status, applicants respectfully submit that these claims are Jepson claims, as they clearly state that "the improvement comprises". Thus, Applicant respectfully submits that there is no lack of clarity with respect to these claims and this grounds for rejection, which applies only to claims 1, 5 and 13-17, should be withdrawn.

With respect to the rejection of claim 23 as being indefinite for being unclear regarding Jepson status, applicants respectfully submit that this claim is in no way a Jepson claim, as this claim intentionally omits the phrase "the improvement comprises". Thus, Applicant respectfully submits that there is no lack of clarity with respect to this claim and this grounds for rejection, which applies only to claims 23-25, should be withdrawn.

Withdrawal of the rejection of claims 1, 5, 13-17 and 23-25, under 35 U.S.C. § 112 second paragraph, based on their status as Jepson claims or not, is respectfully solicited.

With respect to the grounds for rejection relating specifically to claims 9-11, 27 and 28, Applicant respectfully submits the grounds for rejection of claims 9-11, 27 and 28 set forth in Item 3 are improper. With respect to the term "the web" in claims 9 and 27, the first line of each of these claims clearly provides the proper antecedent basis for the term "the web". With respect to the term "the second roll" in claims 9, 27 and 28, applicant has intentionally and consistently set forth in claims 9, 27 and 28 that the second roll does not have to be, and is not limited to being, a buffing roll. These claims set forth "a second roll", not "a second buffing roll". Thus, the term "the second roll" objected to in the Office Action is in fact correct and has proper antecedent basis in these claims.

Withdrawal of the rejection of claims 9-11, 27 and 28 under 35 U.S.C. § 112 second paragraph is respectfully solicited.

With respect to claim 12, while that claim is rejected in Item 3, no grounds for rejection of claim 12 is provided. Withdrawal of the rejection of claim 12 under 35 U.S.C. § 112 second paragraph is respectfully solicited.

IV. Rejections Under 35 U.S.C. § 103

Item 5 rejects claims 5, 16, 17 and 23-25 under 35 U.S.C. § 103(a) as unpatentable over the alleged "admitted state of the prior art" (ASPA) in view of U.S. Patent No. 1,071,519 to Hanish and applicant's submitted product information from Edward H. Best & Co. (Best).

However, Items 8 and 10 indicate that claims 26 and 18, respectively, define subject matter patentable over the references of record. Claims 5 and 23 have been amended to incorporate the subject matter of claims 18 and 26, respectively. Applicant further respectfully

submits that the grounds for rejection of claim 18 under 35 U.S.C. § 112 second paragraph has also been overcome. Thus, Applicant respectfully submits that claims 5, 16, 17 and 23-25 are in condition for allowance. Withdrawal of the rejection of claims 5, 16, 17 and 23-25 as unpatentable under 35 U.S.C. § 103(a) over the alleged ASPA in view of Hanish and Best is respectfully solicited.

V. Conclusion

For at least the reasons outlined above, applicant respectfully submits the application is in condition for allowance. Favorable consideration and prompt allowance of claims 1, 5, 9-17, 19-25, 27 and 28 is respectfully solicited.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



Theodore J. Long, Reg. No. 20,648
Stephen J. Roe, Reg. No. 35,463
Attorney for Applicant
Lathrop & Clark LLP
740 Regent Street, Suite 400
P.O. Box 1507
Madison, Wisconsin 53701_1507
(608) 257_7766

amdt.res